



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/646,192

08/21/2003

Scott F. Watson

0260257

9068

63649

7590

11/09/2010

DISNEY ENTERPRISES

C/O FARJAMI & FARJAMI LLP

26522 LA ALAMEDA AVENUE, SUITE 360

MISSION VIEJO, CA 92691

EXAMINER

HUYNH, SON P

ART UNIT

PAPER NUMBER

2424

MAIL DATE

DELIVERY MODE

11/09/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/646,192	Applicant(s) WATSON ET AL.	
	Examiner SON P. HUYNH	Art Unit 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-34, 41 and 170-177 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-34, 41 and 170-177 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 30-34, 41, 170-177 have been considered but are moot in view of the new ground(s) of rejection.

Claims 1-29, 35-40, 42-169 have been canceled.

Claim Objections

2. Claims 33, 172 are objected to because of the following informalities:

Claim 33 and claim 172, limitation "terrestially" should be replaced as --
terrestrially.

Appropriate corrections are required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 30-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based upon consideration of all of the relevant factors with respect to the claim as a whole, claims 30-34 are held to claim an abstract idea, and is/are therefore rejected as ineligible subject matter under 35 U.S.C. 101. The rationale for this finding is explained below:

Claims 30-34 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of *In Re Bilski* 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The claimed method comprising receiving.., is broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent. For example, "receiving movie data at a hardware device..." could be performed mentally or by a box or a container that receive DVD or VCD, etc. with information about languages and other information regarding the video on a piece of paper or on the label; the step of "storing on said hardware device....." could be interpreted as storing/placing on the box or container DVD or VCD with video files; "filtering...discarding..." could be performed by a person looking through information on the piece of paper or on the label and sort out/select the DVD, VCD, etc. to keep or to throw away/discard based on languages on each DVD, VCD, etc.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 30-34, 41, 170-174 and 176 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis (US 7,051,360 B1) –hereinafter referred to as Ellis.

Note: US 2003/0149988A1 (hereinafter referred to as E988), US 2003/0149980 A1 (hereinafter referred to as E980) and other documents that are incorporated by reference in E360 in their entireties (see include, but not limited to, E360: (col. 9, lines 1-4, 65-col. 10, line 7, col. 12, lines 5-10) are treated as part of the specification of E360.

Regarding claim 30 Ellis discloses a method of creating a digital home movie library (see figures 1-4; E988: figures 2A-2b, 4, 7,9), the method comprising:

receiving movie data at a hardware device, the movie data including a video file, a plurality of audio files each in a different language, and associated metadata, wherein the associated metadata include a language attribute for each of the plurality of audio

Art Unit: 2424

files (receiving movie/video/program data at interactive program guide equipment and/or video server and/or user television equipment, the movie/video data include a video files and a audio files in different languages and associated metadata such as program title, language attributes, program channel, etc. wherein language attributes are used to identify each audio files - see—include, but not limited to, figures 7a-7b, 10, 13-16, col. 3. lines 50-57, col. 4, line 1-col. 5, line 1, col. 8, lines 13-32, col. 9, lines 5-50, col. 12, lines 11-63, col. 13, line 30-col. 14, line 34, col. 15, line 25-col. 16, line 21, col. 19, lines 1-11, line 62-col. 20, line 8);

storing on the hardware device the video file (storing on video server and/or storage devices of user television equipment the video files of selected programs - see include, but not limited to, figures 2b-4, col. 8, line 13-col. 10, line 6; E988: figures 2b-7, 9, paragraphs 0096-0104, 0113-0114; E980: figure 2-3, paragraphs 0008, 0019-0021, 0053);

filtering the plurality of audio files based on the language attribute for each of the plurality of audio files and a user's selected language stored in the hardware device to select desired one or more of audio files from the plurality of audio files (using digital component selector and/or analog audio selector and/or packet filter to filter out audio files based on language attribute in the program and language attribute selected by user to select desired language for the program - see include, but not limited to, figures 2b-4, 7a-7b, 10, 13-16, col. 3. lines 50-57, col. 4, line 1-col. 5, line 1, col. 8, lines 13-32, col. 9, lines 5-50, col. 12, lines 11-63, col. 13, line 30-col. 14, line 34, col. 15, line 25-col. 16,

Art Unit: 2424

line 21, col. 19, lines 1-11, line 62-col. 20, line 8; E988: figures 2b-7, 9, paragraphs 0096-0104, 0113-0114; E980: figure 2-3, paragraphs 0008, 0019-0021, 0053);

storing on the hardware device the desired one or more of audio files (storing/recording the selected program with the desired language in storage device at server and/or at user television equipment-see include, but not limited to, figures 2b-4, 7a-7b, 10, 13-16, col. 3. lines 50-57, col. 4, line 1-col. 5, line 1, col. 8, lines 13-32, col. 9, lines 5-50, col. 12, lines 11-63, col. 13, line 30-col. 14, line 34, col. 15, line 25-col. 16, line 21, col. 19, lines 1-11, line 62-col. 20, line 8; E988: figures 2b-7, 9, paragraphs 0096-0104, 0113-0114; E980: figure 2-3, paragraphs 0008, 0019-0021, 0053); and

discarding one or more of the plurality of audio files other than the desired one or more of audio files see include, but not limited to, figures 2b-4, 7a-7b, 10, 13-16, col. 3. lines 50-57, col. 4, line 1-col. 5, line 1, col. 8, lines 13-32, col. 9, lines 5-50, col. 12, lines 11-63, col. 13, line 30-col. 14, line 34, col. 15, line 25-col. 16, line 21, col. 19, lines 1-11, line 62-col. 20, line 8; E988: figures 2b-7, 9, paragraphs 0096-0104, 0113-0114; E980: figure 2-3, paragraphs 0008, 0019-0021, 0053).

Regarding claim 31, Ellis discloses the method as discussed in the rejection of claim 30. Ellis further discloses wherein the movie data are available for a limited time and thereafter are removed (see include, but not limited to, E988: paragraphs 0167-0169).

Regarding claim 32, Ellis discloses the method as discussed in the rejection of claim 30. Ellis further discloses the recorded program is deleted after viewed or the recorded

Art Unit: 2424

program is allowed to access for a predetermined period of time or user has to enter purchase code to view/access the program (see include, but not limited to, E988: paragraphs 0151, 0157, 0168-0169, 0136-0139). Thus, the movie data are inherently encrypted to limit the availability in at least one of the following respects: being copied multiple times, being viewed more than once, or being viewed or copied other than if conditional access is provided so that the video data is only accessed when predetermined condition (e.g., when purchased, or during accessible time, or payment made, etc.) is met.

Regarding claim 33, Ellis discloses the method as discussed in the rejection of claim 30. Ellis further discloses the receiving movie data via communication link 18 or communication link 20 which may be a telephone network link, a cable or fiber option link, a microwave link, an Internet link, a combination of such links, or any other suitable communications link (col. 5, lines 49-55, col. 6, lines 9-30, col. 8, lines 55-57 (corresponding to US 6,820,278: see col. 1, lines 26-35); E988: paragraphs 0059, 0064-0065). Thus, Ellis suggests receiving movie data is via terrestrially broadcast standard television signals.

Regarding claim 34, Ellis discloses the method as discussed in the rejection of claim 33. Ellis further discloses payment for viewing the movie data is made through a wireline (see include, but not limited to, E988: paragraphs 0060- 0061, 0065).

Art Unit: 2424

Regarding claim 176, Ellis discloses the method as discussed in the rejection of claim 30. Ellis further discloses the hardware device is a set top box (see include, but not limited to, figures 3-4, col. 9, lines 5-15).

Regarding claim 41, the limitations of the system that correspond to the limitations of the method of claim 30 are analyzed as discussed in the rejection of claim 30. Ellis further discloses an antenna and a tuner for receiving movie data (see include, but not limited to, figures 3-4, col. 8, line 13-col. 10, line 17; E988: figures 2a-2b, 7, 9, paragraphs 0065, 0098); a hard disk drive (see include, but not limited to, figures 3-4, col. 8, line 58-col. 9, line 15; E980: paragraph 0008, 0086); and control/processing circuitry and/or microprocessor and/or client processor (see include, but not limited to, figures 3-4, 13-16, col. 8, line 10-col. 10, line 6; E988: figures 2a-2b, 7, 9, paragraphs 0077-0078, 0102-0110, 0112-0114) read on the claimed "a processor".

Regarding claims 170-174, the limitations of the system that correspond to the limitations of the method as claimed in claims 31-34, 176 are analyzed as discussed in the rejection of claims 31-34 and 176.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2424

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 175 and 177 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis as applied to claim 30 or claim 41 above.

Regarding claims 175 and 177, Ellis discloses the method and system as discussed in the rejection of claims 30 or 41. Ellis is silent about hardware device a portable device. Official Notice is taken that hardware device is a portable device for receiving data is well known in the art (for example, see Ellis: US 20050028208: paragraphs 0092, 0115). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ellis with the well-known teaching of hardware device is a portable device in order to yield a predictable results such as to improve convenience for user to access multimedia data including movie data.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ellis (US 20050028208 A1) discloses interactive television program guide with remote access.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SON P. HUYNH whose telephone number is (571)272-7295. The examiner can normally be reached on 9:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2424

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Son P Huynh/
Primary Examiner, Art Unit 2424

October 12, 2010